

REMARKS

Claims 1 and 26-37 were pending in the above-captioned patent application prior to this amendment and are still pending. Claims 2-25 were canceled previously. Claims 1, 26, 27, 29, 31, 33 and 34 are amended herein.

The examiner objected to the drawings under 37 C.F.R. § 1.83(a) as not showing the additional expansion zipper and the internal stiffening member which the examiner contends is recited in claims 27 and 32. With regard to the expansion zippers, the examiner's attention is drawn to Fig. 3 in which zip fastener 3A is shown in its opened position to expose gusset 3C. The paragraph on page 6, lines 5-16 of the application as filed explains that the gusset 3C of zip fastener 3A provides volume expandability. The next paragraph of the application explains that "[i]f a multiple volume expansion facility is desired the zip fastener arrangement 3 incorporates additional zip fasteners . . . each having associated therewith an expansion gusset" See page 6, lines 17-20 of the application as filed. Thus, zip fastener 3A with its expansion gusset 3C illustrates what each additional zip fastener having volume expansion capability would look like and the written description is clear on this point. Accordingly, the drawings adequately illustrate the structure being claimed in claim 27. As to claim 32, please note that it does not recite any "internal stiffening **member**" (Emphasis added). Accordingly, no drawing needs to show any internal stiffening member. The piping referred to in claim 27 is shown in the drawings. Accordingly, it is respectfully requested that the objection to the drawings under 37 C.F.R. § 1.83(a) be withdrawn.

The examiner objected to the specification as not providing an antecedent basis for "means of a Zip fastener arrangement." Claim 1 has been amended to remove the phrase "means of." Accordingly, withdrawal of this objection is respectfully requested.

The examiner rejected claims 1 and 26-37 under 35 U.S.C. § 112, second paragraph as being indefinite. In particular, the examiner stated that "Zip" should not be capitalized, that "means of a Zip fastener arrangement" is not a proper 112, 6th paragraph recitation, that "the first pair of wheels" in claim 29 has no antecedent basis, and that "Zip

fastener portions” in claim 33 has no antecedent basis. The word “Zip” has been amended to “zip” throughout the claims to address the examiner’s concern with that particular word. The words “means of” have been deleted from claim 1 so as not to improperly invoke 112, 6th paragraph. Claim 29 has been amended to clarify that “the pair of wheels” of claim 1 “is a first pair of wheels.” Claim 33 has been amended to recited that “the zip fastener arrangement has zip fastener portions.” Accordingly, the portions of the claims that the examiner found indefinite have been rectified and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

The examiner rejected claims 1, 26, 31, 32 and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over Nykoluk (U.S. Pat. No. 6,062,356) in view of Lee (U.S. Pat. No. 5,284,542). The examiner states that “Nykoluk ‘874 meets all claimed limitations except for the material being molded foamed plastic” and that “[i]t would have been obvious to one of ordinary skill in the art to make the case from foamed plastic material as taught by Lee to provide the desired material for the case.” When Nykoluk is modified in the manner suggested by the examiner, the resulting device would not be within the scope of claim 1 because it would have internal framing. Claim 1 requires, among other things, the base and lid portions not to have “any internal/external perimeter framing.” Nykoluk teaches, at col. 2, lines 30-32, “[a]n internal frame 33 made from a substantially rigid material such as plastic extends around outer periphery 26 to provide support for body 17.” Nykoluk goes on to teach, at col. 2, lines 43-45, “[a] wheeled framework 38 is mounted to internal frame 33 at the rear of bottom wall 22 adjacent rear wall 31 (see FIG. 1).” Accordingly, even if a person skilled in the art were going to replace the walls of Nykoluk’s body 17 with Lee’s foamed plastics material, the person skilled in the art would not think is plausible to omit Nykoluk’s frame 33 because Nykoluk’s wheeled framework 38, which carries wheels 41 is mounted to that frame. Lee does not disclose any suitcase with wheels whatsoever, and furthermore, Lee is silent as to the strength of the foamed plastics material. Therefore, one skilled in the art would not have any reason to believe that Lee’s suitcases would be strong enough to support Nykoluk’s wheeled framework 38 without the additional internal frame 33 of Nykoluk. It is submitted that one skilled in the art, knowing the type of forces to which the wheels of wheeled luggage are inherently subjected, would not remove Nykoluk’s frame 33 even if that skilled person were going to replace the panels of body

17 with Lee's foamed plastics material. Thus, claim 1 of the present application is not rendered obvious by the combination of Nykoluk and Lee. Accordingly, withdrawal of the rejection of claims 1, 26, 31, 32 and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over Nykoluk in view of Lee is respectfully requested.

The examiner rejected claims 1, 26, 29, 30, 31, 32, 34 and 35 "under 35 U.S.C. § 103(a) as being unpatentable over Hsieh (U.S. Pat. App. Pub. No. 2005/0056511) in view of either Nykoluk (U.S. Pat. No. 6,062,356), and further in view of Lee (U.S. Pat. No. 5,284,542). The examiner's wording in making the rejection is confusing. The undersigned believes that the word "either" in the examiner's phrase "unpatentable in view of **either Nykoluk . . . , and further in view of Lee . . .**" was inadvertent such that this rejection is a 3-way obviousness rejection based on the combination of Hsieh, Nykoluk, and Lee. This interpretation is consistent with the examiner's reliance on Lee to provide the "foamed plastics material" recitation of claim 1 and reliance on Nykoluk to provide the "zip fastener arrangement that provides both an opening and closing facility for the suitcase and additionally selective expansion of a storage volume of the suitcase" recitation of claim 1. Submitted herewith is a Declaration Under 37 C.F.R. § 1.131 to antedate or swear behind the Hsieh reference. The inventor conceived the subject matter of the present application, including the subject matter recited in claim 1 of the present application, prior to the September 16, 2003 filing date of Hsieh and the invention was diligently reduced to practice. This inventive activity took place in a WTO member country and therefore, 35 U.S.C. § 104 is applicable. Accordingly, because Hsieh cannot be used as a reference to reject the present application and because claim 1 distinguishes over the Nykoluk and Lee references (i.e., the other two references of the 3-way obviousness combination being made to reject claim 1) as discussed above, withdrawal of the rejection of claims 1, 26, 29, 30, 31, 32, 34 and 35 "under 35 U.S.C. § 103(a) as being unpatentable over Hsieh (U.S. Pat. App. Pub. No. 2005/0056511) in view of either Nykoluk (U.S. Pat. No. 6,062,356), and further in view of Lee (U.S. Pat. No. 5,284,542)" is respectfully requested.

The examiner made several rejections under 35 U.S.C. § 103(a) in paragraphs 9-11 to reject dependent claims 27 and 33 (paragraph 9), claim 28 (paragraph 10), and claims 36 and 37 (paragraph 11). However, because each of the rejections in paragraphs 9-11 rely first on

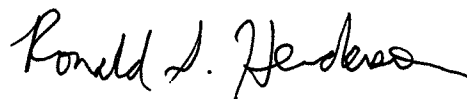
the rejection set forth in paragraph 8 and because the rejection of paragraph 8 has been overcome by the filing of the Declaration Under 37 C.F.R. § 1.131, the rejections set forth in paragraphs 9-11 are moot and have also been overcome. A minor amendment has been made to claim 34 to secure antecedent basis with the phrase "foamed plastics material" recited in claim 1.

Based on the foregoing, claim 1 along with dependent claims 26-37 are in condition for allowance and such action is respectfully requested. The examiner's attention is directed to the fact that the British counterpart patent has now been granted as British Pat. No. 2407560 B, a copy of which is attached hereto in an Appendix. As the examiner can see, claim 1 of the issued British patent is substantially the same as claim 1 pending in the present application. The UK Patent Office has concluded that a suitcase of soft construction of a foamed plastics material without perimeter framing for reinforcing the case (e.g., the frame 33 disclosed in Nykoluk) would not have been obvious in light of the prior art at the time of the priority date of the claimed invention. It is submitted that the U.S. Patent and Trademark Office should reach the same conclusion. This Amendment is being submitted prior to the date two months from the mailing date of the Office Action and should be entered for at the reason that it places the application in better condition for Appeal.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged to the Account of Barnes & Thornburg, Deposit Account No. 10-0435, with reference to our file 38566-79926.

Respectfully submitted,

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